

REMARKS

Reconsideration and allowance of the instant application is respectfully requested in light of the following remarks.

Claim Status

Claims 1, 3, 5-10, and 12-17 are pending. Claims 2, 4, and 11 are canceled. No new matter was added. Claims 18-33 were withdrawn from consideration in view of the restriction requirement.

Restriction Requirement

In the first action Applicant elected of Group I (claims 1-17) and reserved the right to file a divisional application on non-elected group II (claims 18-33).

35 USC § 102 Rejection

Applicant acknowledges that the rejection of Claims 1-4, 12 and 14-17 under 35 USC §102(b), as anticipated by Bretz (US 6,300,468) has been withdrawn. Thank you.

Claims 1-5, 9-14, 16, and 17 stand rejected under 35 USC §102(b), as anticipated by Tabaksblat (US 6,051,618).

Applicant traverses. Applicant disagrees with this rejection

as the Tabaksblat reference fails to constitute an anticipatory reference because Tabaksblat does not individually teach all of the elements of either claims 1-5, 9-14, 16, and 17. To anticipate a claim, the reference must teach every element of the claim (See MPEP §2131).

From MPEP 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdigaal Bros. v. Union Oil Co. of California*, 814 R.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Claims 2, 4, and 11 require that the porous polymer substrate be hydrophilised over at least part of its entire surface with a surfactant with a concentration of between 0.1 wt.% and 15 wt.% relative to the weight of the carrier, which is not described in Tabaksblat.

The examiner avers that Tabaksblat in examples 1 teaches "[t]he porous polyolefin particles contain surfactants in an amount of 1.4% (0.63/45x100) by weight based on 100% by weight polyolefin particles example 1." See Official action page 3.

This statement is incorrect. Looking now to Example 1 of Tabaksblat '618 Applicant agrees that there are 45 g of LDPE, however this material is dissolved in 330 grams of cyclohexane then a solution of nucleating agent was added which include 750

grams of water and .63 grams of surfactant. Therefore the .63 grams of surfactant is in a solution of 45 g LDPE 330 g cyclohexane and 750 g water. In Tabaksblat '618 the solution is then cooled to room temperature where and gel particles are removed from the solution and then dried.

Assuming that the surfactant in example 1 would distribute homogeneously over the phases of the dispersion according to claim 1 this would result in a concentration of the surfactant in the particles of 0.056 wt. % (0.63g surfactant / 45 g LDPE, 330 g cyclohexane and 750 g water). This concentration is far below the minimum concentration of the surfactant in the carrier according to amended claim 1 of the instant invention, which is 0.1 wt. %. Applicant sees nothing in this example which would allow one to ignore the cyclohexane solvent or the 750 g of water. Further there is nothing that teaches or suggests that all the surfactant would migrate to the polymer and none would be left over in the solvent water solution.

Applicant conducted a telephone interview with the examiner on Thursday, April 3, 2008, where applicant tried to explain this point. The examiner replied that because in claim 1 of the instant application no solvent is mentioned and the claim is to the product and not a process the examiner can therefore leave all solvent out.

Applicant respectfully points out that the prior art is good for everything it teaches. It is impermissible for the examiner to look at only what fits a rejection and exclude teachings of the reference that would show it is different from the instant invention.

The prior art is good for everything it teaches, not just the invention it describes or claims. *See EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir. 1985) ("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. On the issue of obviousness, the combined teachings of the prior art as a whole must be considered.")

By the same token, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); *see also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed. Cir. 1986) (holding that the district court, by failing to consider a prior art reference in its entirety,

ignored portions of the reference that led away from obviousness).

In this example the examiner told Applicant that the office only had to consider the LDPE and surfactant, this seems to be a selective picking and choosing in the context of §102 with no regard to what the art actually teaches. In the Tabaksblat '618 reference Applicant sets forth that the particles made by the process of Example 1 would have a concentration of the surfactant in the particles of 0.056 wt. % (0.63g surfactant / 45 g LDPE, 330 g cyclohexane and 750 g water). This concentration is far below the minimum concentration of the surfactant in the carrier according to amended claim 1 of the instant invention, which is 0.1 wt. %.

Now keeping in mind that the prior art is good for everything it teaches, not just the invention it describes or claims, lets take a closer look at Tabaksblat '618. In Example 2, first paragraph is another example with a lower level of surfactant that also works. In example 2 second paragraph the level of surfactant is increased to 1.5 g, by Applicant's calculation this level would represent about 0.133 wt % (1.5g surfactant / 45 g LDPE, 330 g cyclohexane and 750 g water) however Tabaksblat disclosed that with this level of surfactant no well defined particles could be distinguished. Based on the

prior art, Tabaksblat '618, real examples Applicant respectfully requests that the objection to the claims under 35 USC §102(b) be withdrawn and the claims be allowed.

As for the dependent claims in view of Tabaksblat, "If an independent claim is not anticipated by prior art, then its dependent claims, which necessarily include the limitations of the independent claim, are not anticipated either. *Kovin Assoc. v. Extech/Exterior Technologies*, 2006 U.S. Dist. LEXIS 63250 (N.D. Ill. 2006), citing *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed. Cir. 2002). Following *Kovin Assoc.*, dependent claims 3, 5-10 and 12-17 are not anticipated by Tabaksblat and should be allowed.

The examiner has also rejected the pending claims alternatively under 35 USC §103(a), Applicant traverses. Applicant can not understand how Tabaksblat '618 with two examples of particles which would have surfactant levels less than those claimed work in Tabaksblat's process and one example where the surfactant level is increased to be within the range of the instant invention, which does not work, would somehow suggest the claimed subject matter.

35 USC § 103 Rejection

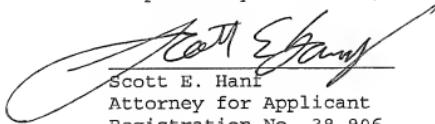
Claims 6-8 stand rejected under 35 USC 103(a) as obvious over Tabaksblat (US 6,051,618) in view of Cohen '547.

Applicant traverses. Applicant sets forth that if Tabaksblat '618 fails to anticipate or suggest the instant invention any combination with Cohen is irrelevant. Applicant respectfully requests allowance of all pending claims in this application.

Final Rejection

Applicant respectfully points out that no claims are amended in this response, the arguments only point out an obvious omission on the part of the office, therefore nothing has been entered by way of this response, which would require a new search, nor has any new issue been brought up, other than the office's obvious omission. Therefore Applicant respectfully requests that this response be entered and the objections overturned.

Respectfully submitted,



Scott E. Hanf  
Attorney for Applicant  
Registration No. 38,906

Customer No. 29494  
Hammer & Hanf, P.C.  
3125 Springbank Lane  
Suite G  
Charlotte, NC 28226  
Telephone: 704-927-0400  
Facsimile: 704-927-0485